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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,036	02/13/2002	John Joseph Mascavage III	020375-002100US	7402
20350 7590 04/16/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER MAGUIRE, LINDSAY M				
ART UNIT 3692		PAPER NUMBER		
MAIL DATE 04/16/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/076,036

**Applicant(s)**

MASCavage ET AL.

**Examiner**

LINDSAY M. MAGUIRE

**Art Unit**

3692

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

This Final Office Action is in response to the application filed on February 13, 2002 and the amendments filed on January 31, 2007, the Appeal Brief filed on October 9, 2007, and the response filed on February 28, 2008.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,699,528 (Hogan '528) in view of [www.tomsown.com/htmlsnippet.html](http://www.tomsown.com/htmlsnippet.html) (Tomsown).

Hogan '528 discloses a method for facilitating payment between a buyer and a seller with an online money transfer performed over a wide area network, the method comprising steps of: receiving login information relevant to a vending site, wherein the login information is associated with the seller (305); automatically determining listings at the vending site associated with the seller (314, 385); generating a plurality of HTML codes for the listings, wherein each code includes a link (Figure 3); automatically inserting one of the plurality of codes into each of the listings, wherein activating the link points a web browser to a payment enabler that can transfer money from the buyer to

the seller (Figure 4); determining the listing has changed (see Figure 4, the word "NONE" indicates that the listing has changed) changing a graphic indicated by the code, which is caused, at least in part, by the determining step (i.e. changing a monetary amount to the word "NONE"). Furthermore, Hogan '528 discloses that one of the plurality of codes indicates a graphic associated with the code and information unique to the seller and a listing including the seller (i.e. the amount of money owed; see Figure 4); wherein the determining step comprises a step of concluding the listing has matured (i.e. bill has been paid or is due), whereby the purchaser is fixed (see Figures 4 and 8B); and the changing step comprises a step of modifying a button graphic displayed by the code to reflect the listing is available to the buyer (i.e. the button changes to say "due"). Hogan '528 further includes the steps of determining one of the plurality of listings has matured (i.e. been paid or is due), whereby the buyer is fixed; automatically determining the electronic address of the purchaser, and automatically sending a message to the electronic address of the purchaser (see Figure 6; 610); automatically sending a message to the electronic address of the purchaser (Figure 6); wherein the message is an e-mail message (610); further comprising a step of determining a purchase price from the vending site (see Figure 4); wherein the message includes a code that points to the payment enabler and includes information relating to a listing associated with the snippet (see Abstract, lines 8-13); further comprising a step of determining from the vending site the e-mail address of the buyer (Figure 6).

Hogan '528 also discloses a step of receiving selection of a button graphic for display by code (Figure 4); receiving authorization from the buyer to debit a money handler associated with the buyer (835); adding a credit in a stored value account of the seller as a result of the receiving authorization step (column 5, lines 1-15); further comprising a step of receiving a shipper selection (i.e. which bill is being paid) and a purchase price (i.e. how much of the bill is being paid); further comprising a step of receiving from the seller a message that is embedded in the plurality of codes for display as part of each listing (i.e. the bill is ready to be paid; 817); further comprising a step of receiving login information relevant to a plurality of vending sites wherein the login information for each of the plurality of vending sites is associated with the seller (813).

Hogan '528 discloses the device substantially as claimed with the exception of requiring the use of html snippets (claims 1-3, 7, 9, 12, 14-16, 21, 22, and 27. However, Tomsown discloses that the use of html snippets in links and buttons is well known in the art to place a link associated with a graphic or button. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify Hogan '528, in view of the teachings of Tomsown, to include the use of HTML snippets for the basic reasoning of creating buttons that act as links for users.

***Requirement for Information Under 37 CFR §1.105***

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. Specifically, it is requested that applicant give a concise statement of the relevance on all cited references who's dates are before 1950. It is unclear to the examiner how references from 1874, 1873, 1908, etc. are relevant to the current application.

***Response to Arguments***

Applicant's arguments filed February 28, 2008 have been fully considered but they are not persuasive.

Applicant's arguments that Hogan does not show a vending site, as defined in a citation of the specification, (cited below):

"[t]ypes of vending sites include auction sites, classified advertising sites, and **other on-line sites** that facilitate person-to-person sales[.]" (emphasis added) are acknowledged, however examiner is of another opinion. Specifically, this definition isn't considered to be a special definition as it sets forth examples of what vending sites are, not what they implicitly have to be.

"Where an applicant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the

disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir.2002), *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP 2111.01. Pursuant to 35 U.S.C. 112 2<sup>nd</sup> paragraph, "[i]t is applicant's burden to precisely define the invention, and not the [examiner's]." Therefore, it would **not** be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the applicant in the written description."

This does not exclude the system of Hogan from being considered a vending site, and therefore Hogan is considered to fully meet the limitations of the claims.

Applicant's arguments that Hogan is missing the limitation, "automatically determining listings at the vending site associated with the seller" are acknowledged, however examiner is of another opinion. Specifically, applicant's specification states:

"[t]hese listings **could be** classified advertisements, electronic advertisements or auctions[.]" (emphasis added).

This definition isn't considered to be a special definition as it sets forth examples of what vending sites are, not what they implicitly have to be, (see above explanation).

Therefore, elements 314 and 385 of Hogan are considered to fully meet the aforementioned limitations of the claims (see Figure 2A).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hogan teaches links, and Tomsown teaches the use of HTML snippets that are used in the creation of links.

Regarding applicant's arguments against the Requirement for Information Under 37 CFR §1.105, the examiner is of another opinion. Specifically, it is unclear how references from 1874, 1873, 1908, etc are considered to be relevant to the current application. The current application deals with vender websites and person-to-person payments over the World Wide Web, which are topics that were not even contemplated in the late 19<sup>th</sup> and early 20<sup>th</sup> centuries. Therefore this requirement is maintained.



***Conclusion***

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts of disclosed by the examiner.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY M. MAGUIRE whose telephone number is (571)272-6039. The examiner can normally be reached on M-F: 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-670202. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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4/14/08 3692  
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